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09/998,111	11/30/2001	Mark W. Hubbard	CA920000060US1	4393

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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/998,111	HUBBARD ET AL.
	Examiner Arthur Duran	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10/7/04.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-55 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-55 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Jeffrey D. Caudill*  
Jeffrey D. Caudill  
Examiner

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1-55 have been examined.

### ***Response to Amendment***

2. The Amendment filed on 10/7/04 is insufficient to overcome the Gerace reference.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 11-21, 23-33, 35-47, 49-52, 54, and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace (5,848,396).

Claim 1, 13, 25, 39: Gerace discloses a system, method, medium, software product for presenting marketing content on a web page, the system comprising:

- (a) a marketing page element, said marketing page element providing storage for data items (Fig. 2; Fig. 3a);
- (b) a web page connected to said marketing page element for presenting said data items (Fig. 2; Fig. 3a); and
- (c) a marketing content selection system connected to said marketing page element, wherein said marketing content selection system is adapted to select said data items to be stored in said marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37; col 5, lines 40-53;

Fig. 4a; col 4, lines 23-29; col 16, lines 41-47; col 17, lines 1-5; col 4, lines 39-45; col 16, lines 55-67).

Additionally, Gerace discloses a marketing page element placed on the web page and that these components are for placing on a web page (col 1, lines 30-45; col 1, lines 60-65; col 6, lines 45-52; col 17, lines 60-67; col 20, lines 10-20; col 16, lines 36-55; col 14, lines 25-35; col 2, lines 24-30; col 4, lines 25-30;).

Gerace discloses design of a webpage and marketing strategy for determining marketing content (col 5, lines 19-24; col 20, lines 10-20; col 12, lines 21-56; col 18, lines 10-26).

Claim 2, 14, 26, 40: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and further discloses that said marketing page element comprises a plurality of marketing page element items, and wherein at least one data item stored in said marketing page element is connected to one of said plurality of marketing page element items (Fig. 4a; col 4, lines 23-29; col 16, lines 41-47; col 17, lines 1-5; col 16, lines 24-29).

Claim 3, 15, 27, 41: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 2, 14, 26, 40, and further discloses that said web page comprises a plurality of web page elements, wherein each of said web page elements is connected to a marketing page element item of said plurality of marketing page element items, and wherein each of said web page elements is used to present a data item connected to said marketing page element item (Fig. 3a; col 5, lines 54-63; col 7, lines 24-37).

Claim 4, 16, 28, 42: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and further

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discloses that said marketing content selection system is adapted to determine data items for storage in said marketing page element in accordance with a marketing strategy (col 12, lines 21-42; col 13, lines 10-20).

Claim 5, 17, 29, 43: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 4, 16, 28, 42, and further discloses that the marketing content selection system determines data items to be stored in said marketing page element based on information available to said marketing content selection system pertaining to the person viewing the web page (Fig. 3b; col 4, lines 20-35).

Additionally, Gerace further discloses taking the information currently displayed on the web page into account (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

Gerace further discloses determining marketing content based on a combination of information displayed on the webpage and information available pertaining to the person viewing the web page (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5; col 2, lines 30-35).

Claim 6, 18, 30, 44: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and further discloses a marketing content retrieval system connected to said marketing page element, said marketing content retrieval system adapted to provide said data items to said marketing page element for storage in said marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37).

Claim 7, 19, 31, 45: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 6, 18, 30, 44, and further

discloses that the marketing content retrieval system comprises a first source of data items, wherein data items are retrieved from said first source of data items for subsequent storage in said marketing page element, said first source of data items comprising at least one of the following: a database, a data stream, a storage device, a memory device (Fig. 2; Fig. 3a; col 3, lines 54-62; col 3, lines 39-42).

Claim 8, 20, 32, 46: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 7, 19, 31, 45, and further discloses that each data item in said first source of data items comprises one of the following: text, an image, an audio file, a video file, a movie, a document, a hyperlink, an animation, an object capable of accepting input, an object capable of presenting output (col 1, lines 31-44).

Claim 9, 21, 33, 47: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 8, 20, 32, 46, and further discloses that the marketing content retrieval system is further adapted to provide at least one data item to said marketing page element from a pre-determined second source of data items in the event that at least one data item to be stored in said marketing page element as determined by the marketing content selection system cannot be retrieved from the first source of data items (col 16, lines 55-67; ).

Claim 11, 23, 35, 49: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and further discloses that the marketing content selection system comprises at least one of the following components: a rules processing engine, a table, a collaborative filtering engine, a selection program (col 16, lines 37-48; col 3, lines 56-61).

Claim 12, 24, 36, 50: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 3, 15, 27, 41, further comprising at least one of the following:

- (i) a first set of tools for making modifications to the manner in which the marketing content selection system determines the data items to be stored in said marketing page element, wherein the modifications can be effected without changing either the layout of said web page elements on said web page or said data items (col 11, lines 24-36; col 11, lines 45-56);
- (ii) a second set of tools for making modifications to said data items, wherein the modifications can be effected without changing either the layout of said web page elements on said web page or the manner in which the marketing content selection system determines the data items to be stored in said marketing page element (col 11, lines 50-55; col 20, lines 13-15; col 6, lines 31-35); and
- (iii) a third set of tools for making modifications to the layout of said web page elements on said web page, wherein the modifications can be effected without changing either said data items or the manner in which the marketing content selection system determines the data items to be stored in said marketing page element (col 6, lines 31-40; col 17, lines 1-5).

Claim 37: Gerace discloses a computer program comprising computer program code means adapted to perform all the steps of claim 13 when said program is run on a computer (Fig. 1; col 3, lines 50-62).

Claim 38: Gerace discloses a computer program as claimed in claim 37 embodied on a computer readable medium (col 3, lines 55-62).

Claim 51: Gerace discloses a computer program product comprising:

a computer-readable signal-bearing medium (col 16, lines 55-60; col 36, lines 49-58; col 3, lines 45-62);

means in said medium for accomplishing the method of any of claims 13 to 24.

Claim 52: Gerace discloses the product of claim 51 wherein said medium is a recordable data storage medium (col 3, lines 55-62).

Claim 54: Gerace discloses the product of claim 53 wherein said signal is a transmission over a network (Fig. 1; col 3, lines 50-54).

Claim 55: Gerace discloses the product of claim 54 wherein said network is the Internet (Fig. 1; col 3, lines 50-54).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 22, 34, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Petty (6,342,907).

Claim 10, 22, 34, 48: Gerace discloses the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39.

Gerace further discloses the utilization of Java and other formats (col 13, lines 51-55) and the utilization of web pages and servers (col 3, lines 54-58; col 1, lines 29-45).

Gerace does not explicitly disclose the utilization of Data Bean or a Java Server Page.

However, Petty implies the utilization of Java Server Pages and discloses the utilization of Data Bean (col 5, lines 20-25; col 9, line 65-col 10, line 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Java Server Pages and Petty's Data Beans to Gerace's utilization of Java, servers, the Internet, and webpages. One would have been motivated to do this in order to provide greater architecture flexibility and platform independence.

5. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396).

Claim 53: Gerace discloses the product of claim 51.

Gerace does not explicitly disclose that said medium is a modulated carrier signal.

However, Gerace discloses the utilization of networks, the Internet, transmissions, satellite, radio, and FM radio (col 16, lines 55-60; col 36, lines 49-58; col 3, lines 45-62) and the display of information along with radio or television transmissions (col 36, lines 49-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's utilization of satellite and radio to Gerace's utilization of networks. One would have been motivated to do this in order to provide the flexibility of a wireless manner of data transmission.

#### *Response to Arguments*

6. Applicant's arguments with respect to claims 1-55 have been considered but are not found persuasive.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Please also note that the additional citations added below have also been added to the rejection above.

On page 18-19 of the Applicant's amendment dated 10/7/04, Applicant presents several statements of features that the Applicant states are not disclosed in Gerace.

Gerace discloses a marketing page element placed on the web page and that these components are for placing on a web page (col 1, lines 30-45; col 1, lines 60-65; col 6, lines 45-52; col 17, lines 60-67; col 20, lines 10-20; col 16, lines 36-55; col 14, lines 25-35; col 2, lines 24-30; col 4, lines 25-30;).

Gerace discloses design of a webpage and marketing strategy for determining marketing content (col 5, lines 19-24; col 20, lines 10-20; col 12, lines 21-56; col 18, lines 10-26).

On page 20 of the Applicant's amendment dated 10/7/04, Applicant states, "However, nowhere does Gerace teach that the information currently displayed on the web page is taken into account".

However, Gerace discloses taking the information currently displayed on the web page into account (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

11/3/04

JMP/CC  
Jeffrey P. Carlson  
Primary Examiner